

REMARKS

This paper is in response to the Office Action mailed April 5, 2004.

Claims 1, 11 and 12 have been amended. New claims 17-22 are presented.

After entry of this amendment, claims 1-13 and 16-22 are pending in this patent application. Support for the amendments and new claims is found in the present application at least at pages 6, 17 and 24-35. No new matter has been added.

Rejection Under 35 USC 103(a)

Claims 1-13 and 16 were rejected as being obvious over the white paper "TCO Discovery Audit for XYZ Publishing Company" (hereinafter "TCO Discovery Audit") in view of the white paper "TCO Analyst." This rejection is traversed for two reasons: (A) because TCO Discovery Audit is not a prior art reference to the present application; and (B) the cited references do not teach the claimed invention.

A. TCO Discovery Audit is Not a Prior Printed Publication:

The Examiner has asserted that TCO Discovery Audit was published in June 1999. The basis for this appears to be the date of "June 1999" that appears with the listing attached to this whitepaper and is reportedly found on the MorganDoyle website at http://www.morgandoule.co.uk/white_papers.htm. This date appears consistent with the alleged copyright date of 1999 on the title page of the white paper. However, Applicant believes that this white paper did not become "published" or sufficiently publicly available until after the present application was filed.

According to MPEP 2128, "an electronic publication, including an on-line database or Internet publication, is considered to be a 'printed publication' within the

meaning of 35 USC 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates." MPEP 2128, page 2100-69.

The undersigned attorney was unable to find evidence of the whitepaper being publicly accessible prior to the filing date of this application, and found evidence that the whitepaper could not have been published in its present form prior to 2002. The following evidence shows this document is not a prior art publication, and the rejection should be withdrawn.

1. Archive Dates of morgandoyle.co.uk website. According to a review on the "Internet Archive Wayback Machine" (<http://web.archive.org>), the earliest date any web page associated with morgandoyle.co.uk appeared was October 30, 2003. Attached behind Tab 1 are several printout results for the following webpages and dates including the webpage of the whitepaper.

<u>Earliest Date</u>	<u>URL</u>
Feb. 21, 2004	http://www.morgandoyle.co.uk/white_papers/Total_Cost_of_Ownership.pdf
Dec. 25, 2003	http://www.morgandoyle.co.uk/white_papers.htm
Oct. 30, 2003	http://www.morgandoyle.co.uk/white_papers/index.htm
Jan. 01, 2004	http://www.morgandoyle.co.uk

2. Creation of MorganDoyle company in 2002. According to the morgandoyle.co.uk webpage for the "History" of the company, which is attached behind Tab 2, the company MorganDoyle was established in 2002. Accordingly, the copyright date of 1999 appearing on the front of the whitepaper showing ownership as of 1999 in MorganDoyle is erroneous. Further, the title page of the whitepaper identifying MorganDoyle with its website and address must have been created no earlier than

2002. This only reasonable conclusion to be drawn is that the version of the whitepaper obtained by the Examiner was not created prior to the filing of the present application.

3. The paper references activity occurring in the United Kingdom. Even if the paper describes activity occurring in 1999, such activity is described as taking place in the United Kingdom. Thus, the paper alone does not represent prior public use or knowledge in the United States under 35 USC 102(a).

B. The Claimed Invention is Not Obvious Over the Cited References

Notwithstanding that the TCO Discovery Audit Whitepaper is not properly a prior art publication, the presently claimed invention is not obvious over the TCO Discovery Audit in view of the TCO Analyst whitepapers. **Claims 1 and 6** recite that the appraisal metrics are assigned to an information technology organizational function category, and reporting the appraisal metrics associated only with the specific category. This feature is neither disclosed nor suggested by the cited references.

The TCO Discovery Audit reference discloses reporting total costs and the percentage breakdown of all costs within the various categories:, i.e. hardware, software, operations, administration, end user ops and downtime. However, the reference does not teach reporting only the appraisal metrics associated with a specific or selected category as recited by claims 1 and 6. Moreover, the reference does not teach associating an appraisal metric with a specific information technology function category other than its source cost account, e.g. see Page 5.

The TCO Analyst reference fails to fill in the gap. The Office Action refers to Figure 5 on page 8 that lists a model TCO Chart of Account proposed by the Gartner

Group. This Gartner Group model proposes four main categories of information technology functions, each with multiple sub-categories. However, the reference teaches at the bottom of page 8 that the Interpose Chart of Accounts shown on Figure 6 page 9 is preferred. So despite the fact that the TCO Analyst lists multiple sub-categories of cost data, it fails to suggest associating the determined appraisal metrics with the categories of service management, systems management, service planning and change management, as recited by claims 1 and 6. Moreover, TCO analyst fails to suggest reporting those appraisal metrics associates only with a selected category.

Moreover, the motivation identified in the Office Action to combine the references does not direct one to modify the way the information is reported in the TCO Discovery Audit reference. The Office Action states that “a general reason it would be useful to include information technology categories into the metric and cost categories would be to determine which area could be most profitably and effectively improved.” However, the natural combination of the two cited references would provide a pie chart or bar graph showing cost breakdowns as in TCO Discovery Audit for all the chart of account sub-groups in TCO analyst – which satisfies the need suggested in the Office Action. There is no suggestion that there is any further need to selectively report appraisal metrics for any selected category, and no motivation to pick and choose the specific categories recited by claims 1 and 6. Therefore, for at least this reason, applicants submit that claims 1 and 6 are not obvious over the cited references.

In addition, **Claim 1** further recites that the “appraisal metrics include financial metrics and non-financial metrics.” Both cited references teach only the determination of financial metrics based on cost data and do not teach the determination of non-

financial metrics. For this separate reason, claim 1 is not obvious over the cited references.

Claims 2-5 and 17-21 are dependent on Claim 1 and, therefore, are also allowable for the reasons noted above with regard to Claim 1.

Claims 7-13, 16 and 22 are dependent on Claim 6 and, therefore, are also allowable for the reasons noted above with regard to Claim 6.

New claims 17-22 recite further details concerning the appraisal metrics. These claims focus on the non-financial metrics. Neither of the cited references teach determining these non-financial appraisal metrics, not even the gathering of the appropriate information from which these metrics may be determined. Further, the cited references fail to suggest the need to incorporate non-financial metrics with the reports on the costs and financial metrics. Therefore, for these additional reasons, these new claims are also patentable.

CONCLUSION

Applicants respectfully submit that the pending claims are in form for allowance in view of the amendments for the reasons noted above. Should the Examiner feel a discussion would expedite the prosecution of this application, the Examiner is kindly invited to contact the undersigned.

Respectfully submitted,



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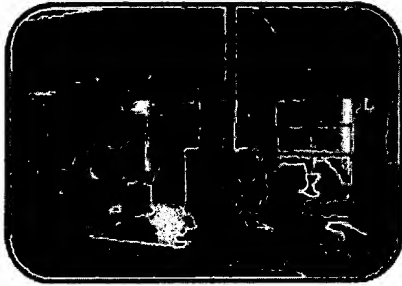
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History

MorganDoyle was established in in 2002 to bring Internet, IT and telecommunications expertise within reach of smaller companies starting out in e-business. Our services bridge the business, operational and technical domains to realize the commercial potential of the Web. Our history and credentials are best described by the [biographies](#) of our two founding partners.

Both have over 20 years experience in the IT and telecommunications sectors, ranging from small start-up companies to corporates such as BT, Nortel and Alstom. They have been working together for more than 15 years specialising in e-business, voice and data networking, disaster recovery, business continuity and operational and business support systems.

Associate Programme

MorganDoyle run an associate programme that is largely resourced from our past contacts who have a proven track record and expertise built from extensive academic research and/or high level business experience. Our success is due to our reputation for delivery based on sound experience and an open and enthusiastic working culture. We are interested in hearing from you if you feel that you qualify for this programme and can add value to our business. Contact us at associates@morgandoyle.co.uk.

Partner Programme

We are keen to forge more mutually beneficial relationships with companies where there is a real synergy and who have skill sets which complement our own. If you would like to explore such a relationship, please contact us at partners@morgandoyle.co.uk.

We are proud to have worked with and happy to endorse the companies on our [partners' page](#).